REMARKS

This amendment is in response to the Office Action dated May 3, 2006. In the amendment, claims 1, 20 and 21 have been amended, such that claims 1-18, 20 and 21 remain pending in the application. Reconsideration of the pending claims is respectfully requested.

This amendment adds no new matter. The specification as filed clearly describes that the e-mail filtering criteria is applied to plural e-mails resident at the e-mail server for the user in question, such as illustrated in FIGs. 7-9 and their related descriptions.

Claims 1-4, 6-18, 20 and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,373,817 to Kung et al. ("Kung") in view of U.S. Pat. No. 6,968,364 to Wong et al. ("Wong"). This rejection is traversed.

Applicant's claimed invention prompts the posting a user-specified notification icon to a set top box in response to determination that e-mail satisfying user-specified e-mail filter criteria is among the various e-mail queued for the user at an e-mail server. This allows the user to be notified in custom fashion with regard to the arrival of particular pieces of e-mail, through the set top box while the user watches television or the like, even where the e-mail server is configured to normally deliver e-mail to the user through other channels.

For example, independent claim 1 now recites: *[a]n apparatus for filtering electronic mail and notifying a user, residing in a set top box connected between a television content provider, an Internet provider having an e-mail server, and a television, comprising:*

a software program application which enables a user to specify e-mail filter criteria and a notification icon which then retains and stores said e-mail filter criteria and said notification icon;

a querying module contained within said software program application which queries said e-mail server to determine whether any e-mail fulfilling said e-mail filter criteria is among a plurality of e-mails for the user that have arrived at said e-mail server; and

a notifying module also contained within said software program application,

wherein, upon arrival of an e-mail fulfilling said e-mail filter criteria, said software program application notifies the user by posting said notification icon to the set top box.

These claimed features are not disclosed or suggested by Kung. Kung discloses a "chase me" technique wherein routing parameters may be changed according to remotely made, user-requested changes in chasing parameters. For example, the chase me technique permits setting a chase me bit when a call is not immediately deliverable and chasing a subscriber even if the message is to be delivered by converting the message to text for delivery by paging the subscriber. (Kung, Abstract).

Kung also discloses details for an IP central station 200 having a multimedia server 222, which is configurable to support e-mail messages. (Kung at column 13, lines 10-12). The multimedia server 222 of Kung also stores messages, and provides a database for indexing, storing and retrieving such messages. (Kung at column 13, lines 20-24). However, provision of this feature merely seems to indicate system support for serving e-mails. There is no indication of any querying to determine whether any e-mail fulfilling e-mail filter criteria has arrived at the server, nor is there any mention of corresponding notification.

Kung also mentions a broadband residential gateway (BRG) 300 that is configurable to provide functionality to a television, including that of a set top box 350. (Kung at Figure 3, column 19, lines 9 and 13-15). In addition, Kung provides a display 338 with touch screen capabilities that allow input via on-screen prompts, on-screen icons, and/or a keypad. (Kung at column 22, lines 52-57). For example, the user may touch an icon representing a pending voicemail and/or multimedia mail message. (Kung at column 22, lines 58-60). In embodiments where the BRG 300 supports multiple mailboxes, the icons may be personalized to show the identity of the owner of the message. (Kung at column 23, lines 23-26).

Thus, Kung appears to disclose a system that allows a user to direct message routing. Additionally, Kung discloses that a set top box may be configured to accommodate the delivery of e-mail messages and related information to users. This is clearly distinct from, and thus there is no disclosure of, allowing a user to specify e-mail filter criteria and a notification icon, pursuant to supporting a querying module that determines whether any e-mail that satisfy the specified e-mail filter criteria is among plural e-mails for the user that have arrived at an e-mail server. Additionally, there no disclosure or suggestion in Kung of a notifying module that accommodates notifying the user by posting the notification icon to the set top box upon arrival of an e-mail fulfilling the e-mail filter criteria. Indeed, the Examiner apparently agrees that these deficiencies are associated with Kung, as noted in the Action. (Office Action, at p. 4).

Wong does not remedy the deficiencies of Kung. Basically, Wong is another example of configuring a set top box to include e-mail functionality. Wong also allows the communication of "tokens" from one location to another, with the tokens representing a selected program "with sufficient particularity to program an entertainment system based upon the token to record the program represented by the token." (Kung, Abstract).

The Examiner refers to various figures, including FIGs. 2-4. FIG. 2 illustrates an example of a set-top box 100, FIG. 3 illustrates a "token application" 300 that provides the token-based functionality, and FIG. 4 illustrates a remote computer system 10. Applicant does not dispute that the set-top box may be configured to including e-mail functionality. However, as with Kung, there is no description of the querying module and notifying module aspects described above.

FIGs. 5-7 are indicated by the examiner as illustrating e-mail notification icons. Although it is unclear exactly what is being referred to as the notification icon, Applicant again does not dispute that something may be graphically displayed in connection with e-mails, whether it is an image corresponding to an open attachment, or the images associated with multiple attached tokens. However, all that these figures appear to disclose is the provision of e-mail functionality and corresponding user interfaces, including the provision of graphics for attachments to the e-mails. There is no disclosure or suggestion of the particular querying module and notifying module features claimed by Applicant.

FIGs. 16 and 17 are said to disclose filtering messages, but they too are lacking with regard to any disclosure of the features of Applicant's claimed invention. FIG. 16 discloses a method for programming a device based upon a token, and FIG. 17 discloses a method for sending tokens corresponding to programs. For example, one user may send a variety of tokens to another user, and may do so using e-mail. A device may receive this information and use it to access video programs or the like. In no case is there any description of enabling entry of user-specified e-mail filter criteria that are then used as the basis for querying whether an e-mail server has any e-mail that satisfy the criteria, and then notifying the user of the presence of such e-mails upon their arrival, by posting the user-specified notification icon to the set-top box.

Wong thus clearly is also devoid of any disclosure of a querying module that queries the e-mail server to determine whether any e-mail fulfilling the e-mail filter criteria specified by

the user is among a plurality of e-mails for the user that have arrived at the e-mail server. Nor does Wong disclose notification upon arrival of an e-mail fulfilling the criteria by posting the notification icon to the set top box. These are features clearly recited in independent claim 1. If the Examiner persists with regard to these grounds, Applicant respectfully requests a clear indication how these features are presented in the relied-upon references.

Since even the combination of Kung and Wong would still fail to yield the features of Applicant's claimed invention, Applicant submits that a *prima facie* case of obviousness has not been presented. Applicant also notes that even if the combination did somehow collectively disclose the recited features, which is not the case, the combination would still be lacking in light of the absence of a proper motivation to combine the references in the offered fashion. There is no reason to believe that the artisan would be motivated to combine the "chase me" routing system of Kung with Wong's token-based system for sending links to video programs and the like.

For reasons similar to those provided regarding claim 1, independent claims 20 are 21 are also neither disclosed nor suggested by the relied upon references. Dependent claims 2-4 and 6-18 incorporate the features recited in independent claim 1, and thus are also not disclosed or suggested by the relied upon references, for that reason and for their separate recitation of patentably distinct features that have been made of record.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-18, 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Kung in view of Wong.

Claim 5 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kung in view of Wong, and further in view of U.S. Pat. No. 6,397,167 to Skinner et al. ("Skinner"). This rejection is traversed.

Claim 5 depends from claim 1 and thus incorporates the above-described querying and notifying features. Skinner does not remedy the deficiencies of Kung and Wong in that regard. Skinner discloses a time and activity tracker wherein a hardware abstraction layer monitors activity on various user input devices. The hardware abstraction layer is a software module which is interposed between actual physical user input devices and the data collector.

There is no apparent description of any kind regarding the querying and notifying features in Skinner.

Accordingly, a *prima facie* case of obviousness is also absent for claim 5, and Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 5 as being unpatentable over the combination of Kung, Wong and Skinner.

For the foregoing reasons, reconsideration and allowance of the claims which remain in the application are solicited. If any further issues remain, the Examiner is invited to telephone the undersigned to resolve them.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

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Respectfully submitted,

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